

## REMARKS

The claims in the present application are claims 1-17 and new claim 18. New claim 18 is directed to the epoxy resin composition of claim 1 containing polybenzoxazine resin. Support for this amendment can be found throughout the specification and claims and in particular at page 1 of the application and in claim 1 as originally filed. No new matter has been added.

The withdrawal by the Examiner of the obviousness-type double patenting rejections over Application No. 10/491,690 in view of Levchik et al. Publication No. 2005/0020800 as well as the Levchik et al. publication in view of Vagose et al. Patent No. 5,945,222 and recognition by the Examiner that the Levchik et al. publication is no longer available as a prior art reference as established in MPEP § 706.02(I)(1), I. Common Ownership or Assignee Prior Art Exclusion Under 35 U.S.C. § 103(c) are gratefully acknowledged by Applicants.

The withdrawal by the Examiner of the 35 U.S.C. 103(a) rejections over Japanese Patent No. 2001-19746 and Japanese Patent No. 2001-302879 in view of Levchik et al., Japanese '746 or Fearing Patent No. 4,268,633 is also gratefully acknowledged by the Applicants.

In the Office Action, claims 1-5, 16 and 17 have now been rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent No. 2002-88138 (JP'138). The Examiner contends that "Although the species of aromatic phosphonic acid ester wherein -X<sub>2</sub> - is a direct bond and -R<sub>2</sub> is an alkyl group as claimed is not exemplified, it is clearly within the purview of formula (II)." For the reasons set forth below, Applicants respectfully traverse the rejection.

Formula (II) of JP' 138 is a generic formula which encompasses an enormous number of phosphorus containing compounds. That is, formula (II), having numerous

variables is sufficiently generic to encompass hundreds, if not thousands, of different phosphorus containing compounds including phosphates, phosphonates, and phosphinates, each of which further encompass many different species.

As held by the C.A.F.C. in *In re Baird*<sup>1</sup>, “the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.” In the *Baird* case, a claim to a bisphenol A was not found to be obvious in view of a prior patent, even though a generic diphenol formula contained a large number of variables that encompassed many different diphenols including the bisphenol A claimed. Similarly, here generic formula (II) of the JP ‘138 reference includes many different variables and therefore as stated above, encompasses many hundreds, if not thousands of phosphorus compounds, among which the phosphonates of the present claims may be found. However, as in the *Baird* case, “the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.” For this reason alone, Applicants respectfully request that the rejection of claims 1-6, 16 and 17 under 35 U.S.C. §103(a) over JP’138 be withdrawn.

Furthermore, with regard to the Examiner’s statement that “it would have been obvious to employ such a phosphonic acid ester based on the equivalency between it and the exemplified species embraced by formula (II)”, it is submitted that merely because a species is encompassed within a genus does not in itself provide the requisite motivation to select the claimed species. That is, none of the cited references provide the motivation to select the claimed species within one of the subgenres disclosed in the genus so as to arrive at the claimed composition and as such the Examiner has failed to provide the requisite motivation to make the claimed invention as

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<sup>1</sup> *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).

a whole. Moreover, JP '138 only exemplifies phosphates. It is respectfully submitted that such a teaching weighs against one skilled in the art selecting the claimed phosphonate species and thus against a determination of obviousness. (See, *In re Baird*, 1522). That is, all 27 examples in JP '138 teach phosphates and thus JP '138 teaches away from making other species within the disclosed genus. (*In re Baird*, 1552). Thus, for these additional reasons the rejection should be withdrawn.

In essence, what the rejection distills down to is that one "would have" or "would have been able to" do what Applicants have done. That, however, is not the standard under 35 U.S.C. 103, and has been long rejected as a substitute for the elements required by the Examiner to meet his burden of establishing a *prima facie* case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300, 1301 and *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Finally, the Applicants respectfully submit that the JP'138 reference does not teach how to make all of the compounds encompassed by the generic formula (II), let alone the phosphonate compounds of the present invention and therefore does not enable one skilled in the art to make the present invention as claimed without undue experimentation.

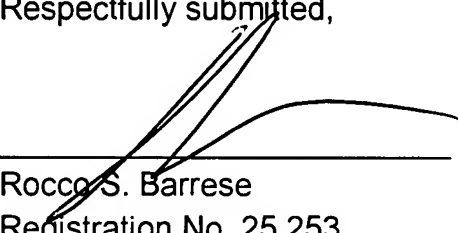
Accordingly, for all of the foregoing reasons, the Applicants respectfully request that the rejection of claims 1-6, 16 and 17 under 35 U.S.C. §103(a) over JP'138 be withdrawn.

In the Office Action, claims 6-15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over JP'138 in view of Japanese Patent No. 2001-302879 (JP '879). In making the rejection, the Examiner has relied on JP '138 for teaching Applicants' phosphonate compounds and has relied on JP '879 for the inorganic filler, co-curing

agent and polybenzoxazine resin. However, for all of the reasons discussed above, JP '138 fails to teach or suggest an epoxy resin composition comprising the recited phosphonates and JP' 879 does cure this factual defect. Accordingly, it is respectfully requested that the rejection of claims 6-15 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP'138 in view of JP '879 be reconsidered and withdrawn.

In view of the foregoing, Applicants respectfully submit that all of the present claims are in condition for allowance and therefore favorable action on the merits and allowance of all claims is earnestly solicited.

Respectfully submitted,



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